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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/109,139	07/02/98	TAYLOR	

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HM42/1113

EXAMINER

ROBINSON, A

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 11/13/98

11/13/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 7-9 and 11-19 is/are pending in the application.
- ☐ Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 7-9 and 11-19 is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

—SEE OFFICE ACTION ON THE FOLLOWING PAGES—

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The preliminary amendment filed July 2, 1998 has been received.

The status of SN: 08/812,865, filed March 6, 1997; and SN: 08/705,594, filed August 30, 1996 should be indicated in the specification.

Claims 7 and 14-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 7 and 14-18 are indefinite in failing to set forth all relative proportions for all ingredients. The functional language in the claims is noted, however, said language does not negate the need for numerical amounts for enhanced combinations.

Claims 7-9, 11-19 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for specific inorganic salts of phosphonate and phosphate inorganic compounds, does not reasonably provide enablement for the inorganic salts of phosphonate and phosphate organic compounds. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The specification fails to set forth any specific organic phosphonate or phosphate compounds.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 7-9 and 11-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7-9 and 13-15 of copending Application No. 08/943,002. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 7-9 and 11-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10-12 and 16-18 of copending Application No. 08/943,002. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method claims in the copending application use the claimed compositions..

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

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A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 7-9 and 11-19 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 7-9 and 13-15 of copending Application No. 08/943,002. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-9 and 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barlet (A), Ducret et al. (B), Horriere et al. (C), Lovatt (D) and Vetanovetz et al. (E).

The Barlet (A), Ducret et al. (B) and Horriere et al. © references teach that the claim designated phosphonate salts are old fungicides. The Lovatt (D) and Vetanovetz et al. (E) references teach that the claim designated phosphate salts are old fertilizers. The above references fail to teach specific examples of the old fungicides and fertilizers together. However, one skilled in this art would find ample motivation from the prior art supra to combine the well known fungicides and fertilizers together, of known properties where the results obtained thereby are no more than the additive effects of the ingredients; particularly since the above prior art teaches the combination of known fungicides and fertilizers. In re Sussman, 1943 C.D. 518. The specification

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fails to set forth any data showing unexpected and/or unobvious results for the claimed combination.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen J. Robinson whose telephone number is (703) 308-4524.

AJR
November 13, 1998


ALLEN J. ROBINSON
PRIMARY EXAMINER
GROUP 1200